

REMARKS

In the present Office Action, claims 1-7 and 9-14 were pending before the Office. Of these, claims 1, 12, and 14 were the only independent claims.

Claims 1-7 and 9-14 were rejected under 35 U.S.C. § 103(a).

No claims are hereby added, amended, canceled, or withdrawn.

A. CLAIM REJECTION UNDER 35 U.S.C. § 103 OF CLAIMS 1-5 AND 12-14

Claims 1-5 and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,671,267 to August et al. [hereinafter *August*]. This rejection is respectfully traversed.

Independent claim 1 recites, inter alia:

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

Independent claims 12 and 14, which each have their own scope, recite similar features.

Manual of Patent Examination Procedure [hereinafter *MPEP*] § 2143.03 requires that "all words in a claim must be considered when judging the patentability of that claim against the prior art." (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 464, 496 (CCPA 1970)). Applicants respectfully note the Office's post-KSR decision in *Ex parte Wada* in which it held that "obviousness requires a suggestion of all limitations in a claim." *Appeal 2007-3733* (BPAI 2008) (citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) citing *In re*

Royka, 490 F.2d 981, 985 (CCPA 1974)(emphasis added)). In sum, it remains well-settled law that an obviousness rejection requires at least a suggestion of all claim features. Because the present rejection in effect ignores directing the set top box to tune to a television event in accordance with the at least one command, the rejection is improper.

Applicants respectfully acknowledge the Office Action's admission that "August does not specifically disclose the command includes directing the set top box to tune to a television event by the calling party." Office Action, page 3, lines 16-17. Beyond the lack of specific disclosure, Applicants respectfully submit that the singular citation to August fails to disclose such a feature.

It is respectfully submitted that, contrary to the contention appearing on line 20 (page 3) of the Office Action, August has not been shown to disclose remotely controlling desired channel numbers and channel up/down functions remotely (e.g., by calling in). Rather, the citations to August discuss calling in and accessing a set top box to enable or inhibit certain channels or signals from reaching a video receiving device. Accordingly, proper consideration has not been given to the above feature of claim 1. Accordingly, it is respectfully submitted that August cannot properly be relied upon for disclosing the above-feature.

Again noting that obviousness requires a suggestion of all features in a claim, it is respectfully submitted that the Office Action fails to establish a prima facie case of obviousness. Accordingly, reconsideration and withdrawal of the \$103 rejection are respectfully requested.

B. CLAIM REJECTIONS UNDER 35 U.S.C. § 103 OF CLAIMS 6, 7, AND 9-11

Claims 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 6,772,436 to Doganata et al. [hereinafter *Doganata*]. Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent Publication No. 2005/0028208 to Ellis et al. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 5,640,453 to Schuchman. Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 6,219,355 to Brodigan.

It is respectfully submitted that the record fails to establish that the various secondary citations add anything that would remedy the above discussed deficiencies in the primary citation to *August*. Thus, each of the proposed combinations of citations fails to disclose each and every feature of the claims.

Favorable review and reversal of the rejections under 35 U.S.C. § 103 are respectfully requested.

Moreover, it is respectfully submitted that the Office Action has provided no reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way Applicants' claims 6, 7, and 9-11 do. As noted in the Office's own examination manual, the United States Supreme Court indicated that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *MPEP* § 2143 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1395-97 (2007)). Simply, for example, stating an object from one of the cited references does not provide any insight, reasoning, or logic that could be properly called "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" and is mere hindsight reconstruction. While inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be

combinations of what, in some sense, is already known, simply finding claim features piecemeal in the prior art references and stating an object from one of the cited references does not provide the reasoning required to maintain a prima facie case of obviousness.

The Office Action merely states that it would have been obvious to combine the teachings, for example, "because it enables viewers to participate in audio conferences that are linked to the programs that they are watching, without the need to dial in to a conference call." Office Action, pages 6-7. The citations to, for example, *August* and *Doganata* - and the Office Action - fail to provide a reason as to why one of skill in the art would be motivated to make such a combination.

In view of the above, it is respectfully submitted that the Office Action has provided no reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way Applicants' claims 6, 7, and 9-11 do. Accordingly, favorable review and reversal of the rejection under 35 U.S.C. § 103 are respectfully requested.

C. CONCLUSION

Since, for at least the above reasons, it is respectfully submitted that all the independent claims are in condition for allowance and all remaining claims properly depend from the independent claims, it is respectfully submitted that all claims are allowable.

It is not believed that a request for extension of time is required but if it is, please accept this paragraph as a request for an extension of time and authorization to charge the requisite extension fee to Deposit Account No. 04-1696. It is not believed that any additional fees are due regarding this

amendment. However, if any additional fees are required, please charge Deposit Account No. 04-1696.

Respectfully Submitted,

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A handwritten signature in black ink, appearing to read 'Christopher Paul Mitchell', with a long horizontal stroke extending to the right.

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